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10/708,562	03/11/2004	Rakesh K. Parimi	FIS920030422	2561
23550 7590 01/25/2008 HOFFMAN WARNICK & D'ALESSANDRO, LLC 75 STATE STREET 14TH FLOOR ALBANY, NY 12207			EXAMINER MASKULINSKI, MICHAEL C	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/708,562
Filing Date: March 11, 2004
Appellant(s): PARIMI, RAKESH K.

Michael F. Hoffman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 21, 2007 appealing from the
Office action mailed May 21, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

(The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2003/0046613

Farchi et al.

3-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9-13 are rejected under **35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. Claims 9-13 are not limited to tangible embodiments. In view of Applicant's disclosure, specification paragraph 0026, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., data storage system) and intangible embodiments (e.g., transmission media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 1-20 are rejected under **35 U.S.C. 102(b)** as being anticipated by Farchi et al., US 2003/0046613 A1.

Referring to claims 1, 9, and 14:

- a. In paragraph 0012, Farchi et al. disclose testing a client program for opening a connection to a server (performing automatic testing of a system including a plurality of modules in which at least two modules lack a predetermined communication mechanism).
- b. In paragraph 0016, Farchi et al. disclose creating a test suite for testing a program (establishing at least one test goal for testing regarding at least one of a module and an interface point between modules; providing at least one test script configured to conduct a test at each module and each interface point).
- c. In paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the

coverage criteria that are input to an automated test generator to create the test cases, which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (generating a test map for each test goal, each test map configured to run at least one test script for each module and each interface point in accordance with the test goal; and automatically testing the system using each test map).

d. With respect to claim 9, in paragraph 0023, Farchi et al. disclose a computer readable medium embodying computer-readable code.

Referring to claims 2, 10, and 15, in paragraph 0026, Farchi et al. disclose that the coverage tool generates a test coverage report based on the test trace and the coverage criteria and this report is utilized to judge the suitability of the program under test (the step of scoring a test result for at least one of the test goal and each test script).

Referring to claims 3, 11, and 16, in paragraph 0030, Farchi et al. disclose that by inputting test traces from multiple test suites, test suites that are too restrictive and/or that are inefficient can be identified and additional criteria can be automatically created to correct those deficiencies (wherein a test script is included in a test map only if the test script has a score that is greater than a threshold score).

Referring to claims 4, 12, and 17, in paragraph 0030, Farchi et al. disclose that by inputting test traces from multiple test suites, test suites that are too restrictive and/or that are inefficient can be identified and additional criteria can be automatically created

to correct those deficiencies (wherein the generating step includes generating a test map for a given test goal only if the given test goal has a score that is greater than a threshold score).

Referring to claims 5 and 18, in paragraph 0026, Farchi et al. disclose that the coverage tool generates a test coverage report based on the test trace and the coverage criteria (further comprising the step of recording a test result for each test script).

Referring to claim 6, in paragraph 0016, Farchi et al. disclose creating a test suite (further comprising the step of recording each test map).

Referring to claims 7 and 19, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases, which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically revise the test cases to correct inadequacies (further comprising the step of repeating the steps of generating and automatically testing after correction of a failure).

Referring to claims 8, 13, and 20, in paragraph 0016, Farchi et al. disclose that the output from the test coverage tool is generated in the same language that was used to write the coverage criteria that are input to an automated test generator to create the test cases which form the test suite. As a result, the output from the coverage tool can be input into the automated test generator to cause the generator to automatically

revise the test cases to correct inadequacies (further comprising the step of modifying the test map based on a modeling rule).

(10) Response to Argument

On page 4, the Appellant argues, "A transmission media, e.g., a carrier signal, is recognized as a physical carrier." The Examiner disagrees for at least the reasons given in the Interim Guidelines found at

<http://www.uspto.gov/web/offices/com/sol/og/2005/week47/patgupa.htm> and the MPEP.

Both of these sources have been ignored by the Appellant.

On page 5, the Appellant argues, "the Examiner asserted that the current invention does not disclose that a transmission media is a carrier signal. Appellant respectfully disagrees because a carrier signal is a way of transmitting data and is thus included as a transmission media. A carrier signal is the only example of a transmission media that may be confused as intangible." The Examiner disagrees. A transmission media may include signals, waves, radiation, links, wires, and fibers. All these are intangible.

On page 5, the Appellant argues, "Appellant respectfully submits again herein that in the specification, the transmission media is an example of memory 22 which stores program product 32. If the transmission media is specified (as an example) as a carrier signal, the carrier signal will be modulated with program product 32. Appellant submits that the mechanisms of data storage in a memory, data transmission, and data modulation in transmission/a carrier signal are well known in the art such that the current specification is sufficient to provide antecedent basis for the claims." The

Examiner disagrees. The disclosed embodiments in the specification are not limited to tangible embodiments. Instead the Appellant uses open ended clauses in the specification that leave it open to intangible embodiments.

On page 6, the Appellant argues, "Farchi does not include providing at least one test script to conduct a test at each module and each interface point (emphasis added by Appellant). Farchi is related to measuring test coverage but never goes to the details of the software system to be tested. As such, Farchi does not disclose that the system to be tested includes a module and/or interface point, and does not disclose at least one test script for each module and/or interface point." The Examiner disagrees. In paragraph 0012, Farchi et al. disclose a method for testing a client program opening a connection to a server and then describes the four distinct methods tested. This is a very detailed description of the software being tested and how it is tested. Further, the Examiner would like to note that in paragraph 0021 of the Appellant's specification a "module" is a component of a system of interest. The description that follows limits a module to almost anything under the sun that can be tested. Also, in paragraph 0022, an "interface point" is a point of communication between two modules. Testing the interaction of a program on a client with a respective server tests two modules (a server and a client), and the interface point (the network connecting the server and the client the and protocols used to make the connection). Further, regarding the limitation of a testing a plurality of modules and interface points, Farchi et al. is concerned with testing software and is never limited to a single test or a single software application. For example, in paragraph 0028, Farchi et al. disclose that any number of test suites may

be run through the test execution engine against the program under test. The method and system of Farchi et al. can be used to develop tests for many different software applications, i.e. a plurality of modules and interface points.

On page 7, the Appellant argues, "The test suite in Farchi includes test cases to achieve test tasks. However, Farchi does not disclose a sequence of the running of test cases. In contrast, 'a 'test map' (in the claimed invention) is a sequence of stored test case to be run in sequence for each module and interface point in accordance with a test goal.' The above specifically provided definition of 'test map' controls the interpretation thereof. As such, Farchi does not include a test map as in the claimed invention. Appellant submits that the assertions of the Examiner regarding creating test cases and revising test case are irrelevant to this feature of the claimed invention because they are not related to a test map, because they are not a sequence of stored test cases to be run in sequence." The Examiner disagrees. Although, the system of Farchi et al. is concerned with developing software tests, Farchi et al. give an example of testing the opening of a connection to a server by a client program (see paragraph 0033). Contrary, to Appellant's belief, this test has to include a sequence of test cases. For example, in conducting this test, one of ordinary skill in the art would not first close the connection, then send data, and then search for a port on the server to send the data to. There is definitely a first, second, third, etc. to conducting this test as there is for many software tests. As another example, one of ordinary skill in the art would not start testing a variable in a program without initializing it first.

(11) Related Proceeding(s) Appendix

Application/Control Number:
10/708,562
Art Unit: 2113

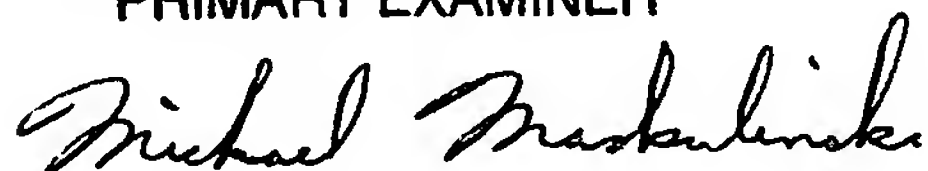
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No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MICHAEL C. MASKULINSKI
PRIMARY EXAMINER



Conferees:

Robert Beausoliel 

Scott Baderman 